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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

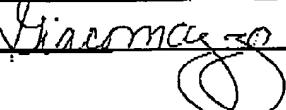
Docket Number (Optional)

RAL919990168US1  
(IRA-10-5853)

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Signature

Typed or printed name Carole Giacomazzo

Application Number

09/839,179

Filed

April 19, 2001

First Named Inventor

Barker

Art Unit

2116

Examiner

Eric Chang

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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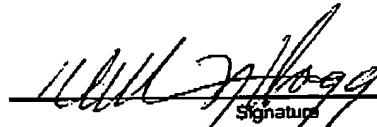
I am the

applicant/inventor.

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record.  
Registration number 20,156

attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_



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OCTOBER 6, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

Total of One forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments or the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## ARGUMENTS

It is the position of Applicants that the rejections of record are clearly not proper and are without basis for the following reasons:

The examiner has rejected claims 1-2 and 4-8 under 35 U.S.C. §102 (b) as being clearly anticipated by U.S. Patent 5,805,597 to Edam, hereinafter Edam, and it is believed that this rejection is clearly in error. Claim 1, upon which claim 2 depends, requires that the low power mode be controlled by elements that determine eligibility based on the time of day, operator controlled signals, non-usage, or a combination thereof. Edam shows entering the low power mode *only* based on non-usage. This is clear from the very passages cited by the examiner to support his position (e.g. col. 8, lines 44-67, and col. 9, lines 1-6). For a §102 rejection, the single reference must show every element of the claim.

Prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim. Jamesbury Corp. v. Litton Indus. Products, 756 F.2d 1556, 225 USPQ 253 (Fed. Cir. 1985); Atlas Powder Co. v. du Pont, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984); American Hospital Supply v. Travenol Labs, 745 F.2d 1, 223 USPQ 577 (Fed. Cir. 1984). Since Edam *does not* teach suggest selection from a list of criteria, or combinations thereof, but only one criteria to enter low power mode, claims 1 and 2 are clearly allowable thereover.

In addition to this, the arguments as to the allowability of claims 1-2 and 4-8 are set forth in the amendment filed April 18, 2005, on pages 6-7. Briefly these arguments state:

"The examiner states that Edem teaches 'determining eligibility of a system to enter a low power mode based on operator generated signals, time of day, or non-use of the system for a period of time, or a combination thereof' and cites col. 8 lines 44-67, and col. 9, lines 1-6 of Edem. It is respectfully submitted that Edem teaches neither the eligibility criteria nor components (claim 1) nor a protocol (claim 4) nor an exchange of signals (claim 5) for determining eligibility. All that Edem states is that '...it is desirable to provide a secondary operational mode which supports limited communications...and has much lower power requirements than the normal full operational mode or modes.' Thus, there is nothing said about *eligibility* to enter the lower power mode being based on

certain factors, and certainly not any component or protocol or exchange of signals for such."

In the response to these arguments, the examiner cites col. 8 line 67, and col. 9, lines 1-6 (paragraph 14 of the office action dated 07/12/05) regarding selectively having the components enter low power mode. However, there is no suggestion or teaching in Edam that these can be *selectively* actuated. Edam reduces power only in response to non or low usage and there is no suggestion of selectivity. With respect to the response to applicants' arguments concerning selectively detecting and controlling portions of a physical layer (paragraph 16 of the office action dated 07/12/05), there is no suggestion in Edam of selectively detecting and controlling. Indeed, the examiner's entire argument that the features of selectively reducing portions of the various devices is not claimed (paragraph 17 of the office action dated 07/12/05) is not understood since the word "selectively" appears in the appropriate claims.

The examiner has rejected claims 9-20 under 35 U.S.C. §103 (a) as being unpatentable over Edam in view of U.S. Patent 6,360,327 to Hobson, hereinafter Hobson. This rejection is not thought to be well taken. First, each of these claims is dependent directly or indirectly on an allowable independent claim, and Hobson does not cure the defects. Moreover, the reasons for allowance of these claims are clearly set out in the amendment filed April 18, 2005, page 7 thereof. The applicants would like to stress that the Hobson device is *not* in the communications field and, therefore, is not properly combined with Edam.

For the sake of convenience, a copy of the claims under appeal, namely 1, 2 and 4-20, is attached hereto.

**Claims Pending in Application Serial No. 09/839,179**

1. A method of conserving power consumption in a communication system which includes components capable of selectively entering a low power operating mode, components capable of determining eligibility of the system to enter a low power operating mode based on operator generated signals, time of day, or non-use of the system for a period of time, or a combination thereof, and an auto-negotiation feature by exchanging messages indicative of a low power operating mode capability, using an auto-negotiation feature to interpret exchanged signals to verify that connected systems include the low power mode capability and eligibility to enter the low power mode, and transmitting a signal that a communications session is completed to cause connected systems to enter the low power mode.
2. The method of claim 1 wherein said auto-negotiation feature is a next-page facility.
4. In a system utilizing a data communication device having a plurality of data exchange modes, each of said modes operating at different speeds, one of which speeds consumes less power than another, protocol means for compatibly coupling said data communication device to another data communication device for exchanging data therebetween, and selection means in said data communication device for a data exchange mode having a higher speed than the others, a method for switching to a least power consuming speed which consumes less power when in an idle mode, by exchanging data representative of said data communication devices ability and eligibility to operate at the least power consuming speed, decoding via said protocol means said

representative data, and changing to said least power consuming speed in response to another protocol signal.

5. In a local area network which includes Ethernet data terminal equipment capable of low power modes and employing auto-negotiation, a method for conserving power consumption during periods of low usage by using a next-page aspect of the auto-negotiation feature to communicate among terminal data equipment each equipment's capability to assume a low power mode, detecting periods of low network usage, verifying in response to detection of low network usage that each equipment is eligible to assume the low power mode by use of the auto-negotiation feature, and asserting signals to put each eligible equipment in a low power mode of operation.

6. The invention as defined in claim 1 wherein the components to put the system in low power mode are selectively detectable and control portions of a physical layer device in said system.

7. The invention as defined in claim 4 wherein the protocol to put the system in low power mode selectively detects and selectively controls portions of a physical layer device in said system.

8. The invention as defined in claim 5 wherein the method to put the system in low power mode selectively detects and selectively controls portions of a physical layer device in said system.

9. The invention as defined in claim 1 wherein the eligibility to enter the low power mode is stored in the system.
10. The invention as defined in claim 1 wherein the eligibility to enter the low power mode is stored in binary bits in the system.
11. The invention as defined in claim 10 wherein the binary bits are located in an organizationally unique identifier.
12. The invention as defined in claim 10 wherein the eligibility is stored in at least one bit.
13. The invention as defined in claim 4 wherein the eligibility to enter the least power speed is stored in the system.
14. The invention as defined in claim 4 wherein the eligibility to enter the least power speed is stored in binary bits in the system.
15. The invention as defined in claim 14 wherein the binary bits are located in an organizationally unique identifier.
16. The invention as defined in claim 14 wherein the eligibility is stored in at least one bit.

17. The invention as defined in claim 5 wherein the eligibility to enter the low power mode is stored in the system.
18. The invention as defined in claim 5 wherein the eligibility to enter the low power mode is stored in binary bits in the system.
19. The invention as defined in claim 18 wherein the binary bits are located in an organizationally unique identifier.
20. The invention as defined in claim 18 wherein the eligibility is stored in at least one bit.